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10/715,391	11/19/2003	Teruaki Itoh	160-398	5497

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EXAMINER	
GORDON, BRIAN R	

ART UNIT	PAPER NUMBER
1743	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/715,391	ITOH, TERUAKI	
	Examiner	Art Unit	
	Brian R. Gordon	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 2-26-07.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-3 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-3 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed February 26, 2007 have been fully considered but they are not persuasive. Applicant has amended the specification to incorporate new matter not previously disclosed (see below).

The only structural requirements of applicant's invention are (1) conveying means capable of stopping and starting and (2) dispensing means and movable dispensing means.

As presently drafted in the current format, the claims contain numerous narrative portions directed to how one intends to use the positively claimed elements with elements other elements not positively listed as elements of the invention. The plurality of conveyor lanes and master and slave specimen containers are not positively claimed as elements of the invention, hence any recitations directed thereto are not further limiting of the dispensing system.

As such applicants arguments are not commensurate in scope with that of the claims for the features regarded as (1) and (2) are not positively claimed structural limitations. As to feature (3), in view of the fact the conveyor lanes are positively claimed the dispensing means is only required to be movable.

In view of such the previous art rejections are hereby maintained.

New claim 3 doesn't appear to contain any further structural limitations as those required in claim 1. As presently drafted, the positively claimed elements are a conveying mechanism and a movable dispensing unit including a nozzle.

Furthermore the claims have been rejected in view of Roach et al. 6,627,446.

Specification

2. The amendment filed February 26, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The specification, abstract, nor claims previously disclosed the conveying means/mechanism as being the stopping means/mechanism. The stopping means and conveying means were previously claimed as separate, distinct elements.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims previously claimed a stopping means. The stopping means has been deleted and replaced by the conveying means. Where did the original specification disclose the conveying means is also the stopping means?

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Watson et al. US 6,599,476.

Watson et al. disclose pathology sample distribution system having a plurality of containers of different types and the containers each containing a sample for pathology analysis. The system comprises: primary container identification means; the identification means including a bar code scanner to scan bar coded labels and an image analyzer to analyze one or more characteristics of the container and/or the sample in therein; primary container cap removal and replacement means; hopper means having container alignment means for delivering secondary containers each with a closed end and an open end in a vertical position and with the open ends in position (stopped) to receive samples; sample aspiration and/or dispensing means for aspirating and/or dispensing volumetrically proportions of the samples from the primary container; blockage detection means for detecting blockage of flow in the sample aspiration means; secondary container sealing means; secondary container labeling means; secondary container storage means; container conveyance means; wherein in

operation each primary container containing a sample is presented to the identification means and the container is accepted or rejected according to given criteria; the identification means being arranged to reject a container when it fails to detect the given criteria and thereby indicating the presence of an error condition, when the given criteria are detected the cap of the primary container is removed and aliquots of the sample aspirated by the sample aspiration and/or dispensing means are dispensed to the secondary container or containers which are then sealed and labeled and placed in the storage means; and whereby the conveyance of the primary containers and secondary containers between operational steps is via the container conveyance means and the whole process is coordinated and controlled by a computerized laboratory information management system.

3. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Kersco et al. 6,495,369.

Kersco et al. disclose the invention provides improved systems, devices, and methods for analyzing a large number of sample compounds contained in standard multi-well microtiter plates or other array structures. The multi-well plates travel along a conveyor system to a test station having a microfluidic device. At the test station, each plate is removed from the conveyor and the wells of the multi-well plate are sequentially aligned with an input port of the microfluidic device. After at least a portion of each sample has been input into the microfluidic channel system, the plate is returned to the conveyor system. Pre and/or post testing stations may be disposed along the conveyor system, and the use of an X-Y-Z robotic arm and novel plate support bracket allows

each of the samples in the wells to be input into the microfluidic network through a probe affixed to a microfluidic chip (abstract).

Referring now to FIG. 10, the host PC will send a signal to the plate handling equipment to download a plate from input stack 16 to conveyor 14 (conveyor means). The host PC instructs bar code reader 22 to read the code as the plate passes by (or is held adjacent to) the bar code reader, and the bar code reader returns the read code to the host PC. This code will typically be logged into a data file for the run. In preparation for dilution, dispense head 30 (dispensing means) will aspirate the appropriate volumes of assay buffer from a buffer reservoir located below the deck of system 10. Pins (stopping means) can be used to hold plate 12 in position at dilution station 24, and the dispense head then deposits the assay buffer in the wells so as to reconstitute the samples.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaw US 5,576,214.

Shaw discloses a chemical analyzer. By way of example, the 1, 2 or 3 aspirators 50 (dispense means) preferably move, arrow 74, to an aspirate station 100 into which a tray 102 of tubes 104 bearing patient sample liquid is pushed, arrow 106, such tray for example being one of those described in U.S. Pat. No. 5,008,082. The aspirator is then lowered into one of the tubes 104 (that is stopped), and aspirates some liquid into the tip. It is then raised and moved further, arrows 110, to a dispense station 112. A plurality of slide test elements is then conveyed (conveyor means), arrow 116, into station 112, for example, 3 such elements E spaced apart on a pusher blade 114. The aspirator(s)

are lowered into position above elements E and liquid is dispensed onto them. Blade 114 is then withdrawn, arrow 118, to a transfer station 120 at which another pusher blade 122 is used to push a now-wetted element E off blade 114, arrow 124, into an incubator 126 which can feature a rotating rotor 128 (column 5, line 5).

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams US 3,985,508.

Williams disclose apparatus includes means comprising a delivery track (conveying means) for sequentially conveying specimen-bearing sample containers to a transfer apparatus which steps the sample containers past an aspirating apparatus (dispensing means). A return track conveys the track containers from the transfer apparatus after the aspirating means have automatically aspirated a plurality of test samples from the sample container. The test samples are subsequently released by the aspirating apparatus into corresponding reaction vessels. Means (stopping means) are also provided for transporting the reaction vessels in a closed loop between the aspirating apparatus and a determinating station, all of the reaction vessels containing the test samples aspirated from a particular specimen being transported in rows from the aspirating apparatus to the determinating station in parallel with the sample container from which the test samples were aspirated. Means for selectively adding predetermined amounts of selected reagents are controlled by other means comprising a plurality of switching devices adjacent the return track between the return track and the rows of reaction vessels being transported to the determinating position. In particular, the switching devices are sequentially enabled by the sample cup being

returned on the return track in parallel with the corresponding row of reaction vessels containing the test samples aspirated from the sample cup, and responsively, the reagent dispensing means adds one or more reagents to selected reagent vessels in accordance with a pre-selected program (column 2, line 32).

The transfer means stopping at each aspirating apparatus while the test sample is aspirated from the sample container (claim 2).

Claim Rejections - 35 USC § 102

6. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Roach et al. US 6,627,446.

Roach et al. discloses a robotic instrument comprising conveying means including a plurality conveyors (lanes) capable of carrying various containers and being started and stopped. Furthermore the device includes a dispensing unit further comprising a plurality of nozzles, pipettes, etc. The dispensing unit is capable of moving across the paths of the conveyors (see figure 1).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, Telework Thurs., 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BRIAN R. GORDON
PRIMARY EXAMINER

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Primary Examiner
Art Unit 1743

brg